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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/530,515

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EXAMINER

BERNSHTEYN, MICHAEL

ART UNIT

PAPER NUMBER

1796

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DELIVERY MODE

12/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/530,515	Applicant(s) SUNAGAWA ET AL.	
	Examiner MICHAEL M. BERNSHTEYN	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action follows a response filed on August 29, 2008. No claims have been amended, cancelled or added.
2. Claims 1-6, 8 and 9 are active.

Claim Rejections - 35 USC § 103

3. The text of this section of Title 35 U.S.C. not included in this action can be found in a prior Office Action.
4. Claims 1-6 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable as obvious over Nakado (JP 2001-098145) in view of Meyer et al. (U. S. Patent 3,153,009), for the rationale recited in paragraph 6 of Office Action dated on June 29, 2008.
5. Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakado (JP 2001-098145) in view of Meyer et al. (U. S. Patent 3,153,009) as applied to claims 1-6 and 9 above and further in view of Carson et al. (U. S. Patent 5,321,056), for the rationale recited in paragraph 7 of Office Action dated on June 20, 2008.

Response to Arguments

6. Applicants traverse the rejection under 35 U.S.C. § 103(a) of claims 1-6 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable as obvious over Nakado (JP 2001-098145) in view of Meyer et al. (U. S. Patent 3,153,009), and the rejection under 35 U.S.C. § 103(a) of claim 8 as being unpatentable over Nakado (JP 2001-

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098145) in view of Meyer et al. (U. S. Patent 3,153,009) as applied to claims 1-6 and 9 above and further in view of Carson et al. (U. S. Patent 5,321,056). Applicant's arguments have been fully considered but they are not persuasive.

7. Regarding to the Applicants arguments that newly cited JP '145 relates to a thermoplastic polyester resin composition comprising a polymer containing a group reactive with a carboxylic acid (B-I) and a carboxylic acid anhydride (c) as the essential ingredients, and in this sense, JP '145 does not relate to the thermoplastic polyester resin defined in the present claims (page 3, the last paragraph), it is noted the following. With regard to the limitations of claims 1-3, 6 and 9, Nakado discloses a thermoplastic polyester resin composition, which is obtained by compounding 100 pts. wt. of thermoplastic polyester resin (A) (which corresponds to the claimed component (A)) with 0.1-10 pts. wt. of a carboxylic acid reactive group-containing polymer (B-I) and/or a compound (B-2) containing plural oxazoline groups in the molecule and 0.01-5 pts. wt. of carboxylic acid anhydride (abstract). Nakado discloses that when a polymer (B-I) has an epoxy group, it can be obtained from glycidyl methacrylate or metaglycidyl acrylate and **copolymerizable monomer**, such as methyl (meth) acrylate, butyl (meth) acrylate, 2-ethylhexyl (meth)acrylate, etc. The number average molecular weight of the polymer (B-1) has the desirable range of 1,000-20,000, which is within the claimed range (pages 3-4, [0018]-[0020]). The polymer (B-1) corresponds to the claimed viscosity modifier.
8. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the physical properties, moldability, etc.) (page 4, 1st paragraph) are not recited in

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the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

9. Regarding the Applicants arguments between the test results in JP'145, and that further incorporation of the carboxylic acid anhydride (C) is essential (page 4, 2nd and 3rd paragraphs), it is noted that Nakado discloses that the loading of carboxylic acid anhydride is desirable in the amount of 0.01-3 wt. parts, which cannot be considered as essential (page 5, [0025]).

Furthermore, it is well settled that "an applied reference may be relied upon for all that it would have reasonably suggested to one of ordinary skill in the art, including not only preferred embodiment, but less preferred and even non preferred". *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989).

10. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning and teaches away (page 4, 4th paragraph), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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11. In response to the arguments that the present claims recite a viscosity modifier consisting essentially of units (a), (b) and (c), and thus, the linear polymer of the viscosity modifier blend taught by Meyer et al is excluded by the present claims because the ethylene would adversely affect the basic and novel characteristics of the present invention (page 5, 2nd paragraph), it is noted that Meyer discloses a toughened blend of an aromatic polyester, preferably an alkylene terephthalate, and most preferably poly(butylene terephthalate), with from 5 to 20 parts (per 100 parts of polyester) of an impact modifier, which is a blend of (a) 80 to 85 weight percent of a core/shell impact modifier having (1) from 70 to 90 parts of a core of a rubber which is a homopolymer of butadiene or a copolymer of butadiene with up to about 30% of at least one copolymerized vinyl monomer; (2) at least one shell, which shell is a homopolymer of methyl methacrylate or a copolymer which contains a majority of units derived from either methyl methacrylate or styrene (col. 6, claim 1). Therefore core/shell impact modifier of Meyer does not contain ethylene units.

12. Furthermore, it is noted that in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to the arguments regarding unexpectedly superior effects (page 6), it is noted the following.

It is well settled that the Applicants have to use the closest prior art to run a consecutive “back-to-back” test to show unexpected results, if any. “Showing unexpected results over one of two equally close prior art references will not rebut prima facie obviousness unless the teachings of the prior art references are sufficiently similar to each other that the testing of one showing unexpected results would provide the same information as to the other”. *In re Johnson*, 747 F.2d 1456, 1461, 223 USPQ 1260, 1264 (Fed. Cir. 1984). Objective evidence which must be factually supported by an appropriate affidavit or declaration to be of probative value includes evidence of unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant. See, for example, *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984) (“It is well settled that unexpected results must be established by factual evidence.” “[A]ppellants have not presented any experimental data showing that prior heat-shrinkable articles split. Due to the absence of tests comparing appellant’s heat shrinkable articles with those of the closest prior art, we conclude that appellant’s assertions of unexpected results constitute mere argument.”). See also *In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972); *Ex parte George*, 21 USPQ2d 1058 (Bd. Pat. App. & Inter. 1991). See MPEP 716.01(c).

13. In response to applicant's argument that Aurenty reference is not an analogous art, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when

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the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter, 1985).

14. In response to the arguments against the references of Saito (JP 62-187756) and Deyrup et al. (U. S. Patent 4,912,167), (page 2, 2nd paragraph), it is noted that it was obvious typing error and these references were not used in the rejection.

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL M. BERNSHTEYN whose telephone number is (571)272-2411. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael M. Bernshteyn/
Examiner, Art Unit 1796

/M. M. B./
Examiner, Art Unit 1796

/Randy Gulakowski/
Supervisory Patent Examiner, Art Unit 1796